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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,957	09/05/2003	Michael Gausclmann	ATR-A-118	8916
32566 7590 06/27/2007 PATENT LAW GROUP LLP 2635 NORTH FIRST STREET SUITE 223 SAN JOSE, CA 95134			EXAMINER HALL, ARTHUR O	
			ART UNIT 3709	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/655,957

Applicant(s)

GAUSELMANN, MICHAEL

Examiner

Arthur O. Hall

Art Unit

3709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2, 4 or 21 and 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3 and 23, respectively, of copending Application No. 10/658,566 (US Patent Application Publication 2005/0054414; Gauselmann). Although the conflicting claims are not identical, they are not patentably distinct from each other because every element of claims 2, 4 or 21 and 17 are found in claims 1, 3 and 23, respectively, in the disclosure of Application No. 10/658,566.

Claims 1, 3 and 23 of Application No. 10/658,566 disclose every limitation of claims 2, 4 or 21 and 17, respectively, of Application No. 10/655,957 with the exceptions

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of substantially reciting generating winning and non-winning outcomes and plural bonus awards. However, Gauselmann discloses that random display of symbols combinations as outcomes across plural paylines in a primary game to generate bonus awards in a bonus game (paragraph 0005 and 0029, Gauselmann). Additionally, Gauselmann discloses that bonus awards based on a player's wager are plural (paragraph 0040, Gauselmann).

Hence, it would have been obvious to one having ordinary skill in the art to modify claims 1, 3 and 23 of Application No. 10/658,566 to provide random selection of values to be displayed as symbols as taught by Gauselmann in order to recite the generation of jackpot or bonus winning and non-winning outcomes from a primary game in claims 2, 4 or 21 and 17, respectively, of Application No. 10/655,957. Additionally, it would have been obvious to one having ordinary skill in the art to modify claims 1, 3 and 23 of Application No. 10/658,566 to provide plural bonus awards based on a player's wager as taught by Gauselmann in order to recite awarding plural jackpots based on a player's bet in claims 2, 4 or 21 and 17, respectively, of Application No. 10/655,957.

The following claim charts show the claim-to-claim comparison between both applications:

10/655,957	10/658,566
Claim 2: A method performed by a gaming device comprising: generating an outcome of a primary game, the primary game generating jackpot winning outcomes and non-	Claim 1: A method performed in a gambling game comprising: displaying an array of symbols in a base game at symbol positions having at least one row and a plurality of columns (see

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<p>jackpot winning outcomes and displaying at least one row and multiple columns of symbols, wherein combinations of symbols across one or more paylines determine the jackpot winning outcomes and the non-jackpot winning outcomes (displaying feature is added from claim 2);</p> <p>offering a plurality of jackpots to a player; and</p> <p>awarding a number of jackpots to a player for a jackpot winning outcome in a current game based on an amount bet by the player for the current game.</p>	<p>random selection of values below);</p> <p>detecting a trigger event that enables a bonus feature;</p> <p>displaying values in at least some of the symbols positions (when values or bonuses are displayed as symbols, these values are thereby seen by the player and thus offered to the player);</p> <p>randomly selecting at least one of the values (in conjunction with displaying the symbol array above is generating an outcome so as to display symbols, of which there are winning and non-winning combinations, as bonus values for bonus game); and</p> <p>awarding a player a bonus award based on the randomly selected value (multiple bonus awards or jackpots based on a player's wager are provided).</p>
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10/655,957	10/658,566
<p>Claim 4 or 21: A method performed by a gaming device comprising:</p> <p>generating an outcome of a primary game, the primary game generating jackpot winning outcomes and non-jackpot winning outcomes;</p> <p>incrementing the plurality of jackpots based on, at least in part, the</p>	<p>Claim 3: A method performed in a gambling game comprising:</p> <p>displaying an array of symbols in a base game at symbol positions having at least one row and a plurality of columns (see random selection of values below);</p> <p>detecting a trigger event that enables a bonus feature by detecting one or more</p>

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<p>occurrence of certain icons displayed in the primary game (added from claim 4);</p> <p>offering a plurality of jackpots to a player; and</p> <p>awarding a number of jackpots or one or more of the jackpots to a player for a jackpot winning outcome in a current game based on an amount bet by the player for the current game.</p>	<p>certain symbols displayed in the base game (detecting plural symbols is added from claim 3);</p> <p>displaying values in at least some of the symbols positions (when values or bonuses are displayed as symbols, these values are thereby seen by the player and thus offered to the player);</p> <p>randomly selecting at least one of the values (in conjunction with displaying the symbol array above is generating an outcome so as to display symbols, of which there are winning and non-winning combinations, as bonus values for bonus game); and</p> <p>awarding a player a bonus award based on the randomly selected value (multiple bonus awards or jackpots based on a player's wager are provided).</p>
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10/655,957	10/658,566
<p>Claim 17: A gaming device comprising:</p> <p>a display screen for receiving signals from a processor for displaying images; and</p> <p>a processor, the processor being programmed to carry out the process of (a processor is at least one processor):</p>	<p>Claim 23: A gaming device comprising:</p> <p>a display for (it being inherent that signals are received from a processor, computer or controller to display the symbols or images)</p> <p>displaying an array of symbols in a base game at symbol positions having at least one row and a plurality of columns (see random selection of values below); and</p> <p>at least one processor programmed for:</p> <p>detecting a trigger event that enables a</p>

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generating an outcome of a primary game, the primary game generating jackpot winning outcomes and non-jackpot winning outcomes;	bonus feature; (see displaying plural symbols and randomly selecting values)
offering a plurality of jackpots to a player; and	controlling the display for displaying values in at least some of the symbols positions (when values or bonuses are displayed as symbols, these values are thereby seen by the player and thus offered to the player); randomly selecting at least one of the values (in conjunction with displaying the symbol array above is generating an outcome so as to display symbols, of which there are winning and non-winning combinations, as bonus values for bonus game); and
awarding a number of jackpots to a player for a jackpot winning outcome in a current game based on an amount bet by the player for the current game,	awarding a player a bonus award based on the randomly selected value (multiple bonus awards or jackpots based on a player's wager are provided),
thereby awarding the same number of jackpots as credits bet for the current game.	wherein the randomly selected value is a credit value (each value or bonus or jackpot is equal to a respective credit value).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8, 10-12, 14-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Baerlocher (US Patent 7,029,395; hereinafter Baerlocher '395). Figures are described with reference characters where necessary for clarity.

Regarding claim 16,

a gaming device (column 6, lines 31-45, Baerlocher '395) comprising:

a display screen for receiving signals from a processor for displaying images (column 7, lines 19-39, Baerlocher '395); and

a processor, the processor being programmed to carry out the process of (column 7, lines 40-49, Baerlocher '395):

generating an outcome of a primary game, the primary game generating jackpot winning outcomes and non-jackpot winning outcomes (column 6, lines 52-56 and column 9, line 62 to column 10, line 29, Baerlocher '395; a primary game generates an outcome for winning certain progressive jackpot values and non-jackpot award values);

offering a plurality of jackpots to a player (column 9, lines 28-47, Baerlocher '395; jackpots of any value are offered once displayed to a player); and

awarding a number of jackpots to a player for a jackpot winning outcome in a current game based on an amount bet by the player for the current game (column 11, lines 27-67 and column 15, lines 16-37, Baerlocher '395; plural jackpots are awarded to the player for a winning outcome of a game machine based on a player's bet amount).

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Regarding claim 1, the scope of the claim is substantially the same as claim 16 above with the only difference being that claim 16 is an apparatus claim and claim 1 is a process claim.

Regarding claim 18, the scope of the claim is substantially the same as claim 16 above with the only differences being that claim 16 is an apparatus claim and claim 18 is a process claim, that the primary game displays the plural symbols in at least one row and in multiple columns (Figs. 1A and 1B, 34, Baerlocher '395), that each jackpot is associated with a column (column 9, lines 28-47, Baerlocher '395; jackpots are displayed in reel columns upon spinning reels), and that a jackpot associated with a particular column is incremented when a jackpot-incrementing symbol is displayed in that column (column 10, lines 30-55, Baerlocher '395; the jackpot amount is incremented when a jackpot-incrementing symbol or "7" symbol occurs in an adjacent column three times).

Regarding claim 21, the scope of the claim is substantially the same as claim 16 above with the only differences being that claim 16 is an apparatus claim and claim 21 is a process claim, that one or more jackpots, which are a number of jackpots are awarded (column 11, lines 27-67 and column 15, lines 16-37, Baerlocher '395; at least one jackpot is awarded), and the plurality of jackpots are incremented based on, at least in part, the occurrence of certain icons displayed in the primary game (column 18, lines

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32-47, Baerlocher '395; plural awards or jackpots are increased or incremented based on plural icons or shields in the game).

Regarding claim 2, generating an outcome of a primary game comprises displaying at least one row and multiple columns of symbols, wherein combinations of symbols across one or more paylines determine the jackpot winning outcomes and the non-jackpot winning outcomes (column 6, lines 52-56, column 8, lines 32-44 and Figs. 1A and 1B, 34, Baerlocher '395).

Regarding claim 3, there are three rows and five columns of symbols in the primary game (Figs. 1A and 1B, 34, Baerlocher '395).

Regarding claim 4, incrementing the plurality of jackpots based on, at least in part, the occurrence of certain icons displayed in the primary game is disclosed (column 18, lines 32-47, Baerlocher '395; plural awards or jackpots are increased or incremented based on plural icons or shields in the game).

Regarding claim 5, incrementing the plurality of jackpots based on, at least in part, a percentage of wagers bet by one or more players is disclosed (column 18, lines 47-67, Baerlocher '395; a player's chance of winning an award or jackpot is based on the odds or odds constants or percent of wager increase).

Regarding claims 6 and 17, detecting a number of credits bet on a primary game, wherein awarding a number of jackpots comprises awarding a number of jackpots equal to the number of credits bet for the primary game, or in other words, awarding the same number of jackpots as credits bet for the current game is disclosed (column 15, lines 56-67, Baerlocher '395; betting the same amount per payline in a game provides the same number of jackpot spins).

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Regarding claim 8, replacing the number of jackpots won with one or more other jackpot amounts is disclosed (column 17, lines 37-50, Baerlocher '395; plural spins or other outcomes of a second bonus game replace first bonus round awards or jackpots won).

Regarding claim 10, awarding a number of jackpots comprises awarding the plurality of jackpots to the player when the primary game generates a jackpot winning outcome and the player makes a maximum bet (column 11, lines 27-46, Baerlocher '395).

Regarding claim 11, the plurality of jackpots comprises progressive jackpots incremented over time (column 9, line 62 to column 10, line 9, Baerlocher '395; jackpots are progressively incremented over time).

Regarding claim 12, the gaming device is one of a plurality of gaming devices having a common plurality of jackpots (column 6, lines 34-45, column 13, lines 50-53, column 14, lines 36-46, column 15, lines 56-58 and Figs. 1A and 1B, 34, Baerlocher '395; one of the plural gaming device has common plural jackpots).

Regarding claim 14, the primary game comprises displaying a plurality of symbols in at least one row and in multiple columns, each jackpot being associated with a column, the method further comprising incrementing a jackpot associated with a particular column when a jackpot-incrementing symbol is displayed in that column (column 9, lines 28-47, column 10, lines 30-55 and Figs. 1A and 1B, 34, Baerlocher '395; the jackpot amount is incremented when a jackpot-incrementing symbol or "7" symbol occurs in an adjacent column three times).

Regarding claim 15, after awarding a number of jackpots, remaining jackpot amounts are shifted to different columns (column 17, lines 7-25, Baerlocher '395; a shift in bonus level odds from a first level to a second level indicates a shift in jackpot

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amounts occurring in different columns of a reel spin that indicates award of plural jackpots in the bonus round is complete).

Regarding claim 19, awarding a number of jackpots to a player for a jackpot winning outcome in a current game based on an amount bet by the player for the current game (column 11, lines 27-67 and column 15, lines 16-37, Baerlocher '395; plural jackpots are awarded to the player for a winning outcome of a game machine based on a player's bet amount).

Regarding claim 20, the jackpot incrementing symbol is a value (column 10, lines 30-55, Baerlocher '395; the jackpot-incrementing symbol or "7" symbol is a value).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claims 7, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher '395 in view of Baerlocher (US Patent 7,001,273; Baerlocher '273).

Figures are described with reference characters where necessary for clarity.

Baerlocher '395 substantially teaches all features of the claimed invention as described above.

However, Baerlocher '395 does not substantially teach hidden jackpots and stand-alone gaming devices as claimed. Therefore, attention is directed to Baerlocher '273, which teaches

Regarding claim 7, the plurality of jackpots comprises visible jackpots that may be won by a player for a current game and hidden jackpots that may be won by a player in future games (column 8, lines 15-26, column 8 line 53 to column 9, line 3 and Fig. 4A, 100 and 114, Baerlocher '273; displayed offers are provided in a base or bonus or secondary game and hidden offers are provided in certain future games).

Regarding claim 9, the other jackpot amounts comprise hidden jackpot amounts that were not visible to the player in the previous game (column 9, lines 35-67, Baerlocher '273; hidden offers are randomly generated, but not revealed to a player until the player rejects a displayed offer in a current game).

Regarding claim 13, the gaming device comprises a stand-alone gaming machine, and the plurality of jackpots apply for that gaming device only (column 5, line 57-67, Baerlocher '273).

Baerlocher '273 suggests that a device that provides new bonus rounds having an offer an acceptance scheme allowing a player to accept and reject awards will help the gaming industry to harness players from the increased popularity in these types of bonus schemes (column 2, lines 23-48, Baerlocher '273).

Thus, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to modify Baerlocher '395 in view of the teachings of Baerlocher '273 for the purpose of providing the gaming device of Baerlocher '395 having jackpot and non-jackpot winning outcome features that are interchangeable with or upgradeable to the hidden jackpot and stand-alone gaming device features of Baerlocher '273 in order to assist the gaming industry in capturing players resulting from the great popularity in offer and acceptance type bonus schemes.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

C US-6,210,275 B1, Olsen

D US-6,217,448 B1, Olsen

E US-6,322,309 B1, Thomas et al.

F US-6,190,255 B1, Thomas et al.

G US-6,159,097, Gura

H US-6,311,976 B1, Yoseloff et al.

I US-6,416,409 B1, Jordan

J US-2004/0242311 A1, Haag et al.

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K US-6,893,344 B2, Brown et al.

L US-6,626,758 B1, Parham et al.

M US-6,800,026 B2, Cannon.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur O. Hall whose telephone number is (571) 270-1814. The examiner can normally be reached on Mon - Fri, 8:00am - 5:00 pm, Alt Fri, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jackson can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AH

6/19/2007

